

71480 U.S. PTO



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Trick 201-AB/KGB
"SEALED PACKAGE OF FILM..."

Applicant : Robert T. Trick
Serial No. : 08/100,019
Filed : July 30, 1993
For : SEALED PACKAGE OF FILM FOR PRODUCING FRAMED
PHOTOGRAPHS
Art Unit : 2101
Examiner : N. Tuccillo

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February 10, 1997

Hon. Assistant Commissioner
for Patents
Washington, D. C. 20231

Sir:

APPELLANT'S BRIEF

This is an appeal from the Final Rejection of claims 1-8 in this application.

This brief is submitted in triplicate as required by 37 C.F.R. 1.192(a).

This brief is accompanied by the requisite fee of \$150.00 as set forth in

37 C.F.R. 1.17(f).

REAL PARTY IN INTEREST

The real party in interest is the inventor, Robert Trick.

RELATED APPEALS AND INTERFERENCES

Appellant is aware of no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-8 are pending in the application.

Claims 1-8 stand rejected under 35 U.S.C. 101 as non-statutory subject matter.

An Appendix annexed hereto contains a copy of the claims involved in the appeal.
The appealed claims are 1-8.

STATUS OF AMENDMENTS

Applicants appeal the decision dated March 5, 1996 of the Examiner finally rejecting all the claims, 1-8 in this application. A timely Response under 37 C.F.R. 1.116 was filed and entered on April 16, 1996. The response adapted the Examiners suggestions recorded in the Examiner's interview summary record dated February 29, 1996 which recommended

addressing the deficiencies in the declaration filed and entered on October 23, 1995. Exhibit A, filed with a new declaration on April 16, 1996, both entered, established applicants priority date to January 2, 1990. Accordingly , the Examiner withdraw all prior art rejections in the Advisory Action dated June 6, 1996. Thus, the only remaining rejection is the 35 U.S.C. 101 rejection of claims 1-8.

SUMMARY OF THE INVENTION

The present invention relates to a novel sealed package of film suitable for producing photographs having a predetermined portion, e.g. a predetermined border. This predetermined portion is an exposed area of film which is independent of the unexposed portion. The unexposed portion can be used independently of the exposed portion to obtain a photograph by conventional exposure. See page 2, lines 1-11 of the present specification.

The sealed package of film is to be opened, put into a camera and exposed to form a plurality of photographs from a plurality of film items to be exposed. The film is conventional type or of instant variety (claim 4). Each film item is comprised of a first unexposed portion and a second exposed portion (claim 1). Upon exposure and development of the first unexposed portion there is formed a picture alongside the picture of the second exposed portion. Advantageously, the second portion at least in part, surrounds the first portion as a picture frame (claim 2). Also, it is possible for the second portions of the film items to not all be identical (claims 6 & 8). See page 2, lines 12-21, and

page 3 lines 1-16 of the present specification.

Specifically, the invention starts with making the second exposed portion. This is accomplished with unexposed film being partially exposed in a manner which does not interfere with the ability of the first unexposed portion to later be exposed (claim 1). The film, partially exposed, is then packaged and later exposed in a conventional manner to form images in the first unexposed portion. The film is then developed such that the newly exposed portion and the pre-exposed portion are simultaneously developed (claims 3 & 5). Alternatively, the pre-exposed(second exposed portion) can be developed before packaging (claim 7). The pre-exposing of the second portions can also be done in a conventional manner. One can block the centers by masking while not blocking the frame, i.e., the second portion to be exposed. Thus, the film can again be exposed and only the unexposed centers (the first unexposed portion) will later pick up an image by exposure. See page 3, lines 22-27, and page 4 lines 1-20 of the present specification.

The invention has no restriction as to subject. The subject can be a person, an object or a scene, and the pre-exposed border can be anything from a Christmas wreath to a vacation scene (claim 2). These pre-exposed films can be purchased as packages for a particular theme, i.e., July 4, such film packages being used for a conventional non-specialized camera. Also, applicant's border makes no restriction on the subject's location or distance from the camera. See page 2, lines 8-12, and page 4 lines 7-16 of the present specification.

ISSUE

The sole issue on appeal is whether the subject matter defined the claims 1-8 is non-statutory subject matter not within 35 U.S.C. 101.

GROUPING OF CLAIMS

Appellants are aware of no reason why the rejected claims do not stand or fall together.

ARGUMENT

I. The Claimed Subject Matter, Taken as a Whole, does not Constitute Non-statutory Subject Matter.

Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Examiner's rejecting claims 1-8 as non-statutory subject matter is improper. The Examiner's reasons for the rejection is that "the claims as now written simply recite a photographic film having defined non-statutory subject matter, i.e. printed subject matter." The rejection is improper in that the claims when considered as a whole, are manifestly drawn to an article of manufacture, i.e., the film, a category of invention expressly defined by 35 U.S.C. 101.

While the Examiner fails to identify that portion of the claim he alleges to be printed subject matter, it is asserted that even if a portion is printed subject matter, the claims must be considered as a whole. Diamond v. Diehr, 450 U.S. 175, 209 USPQ 1 (1981). It is assumed that the printed matter the Examiner refers to is the second exposed portion in the claims as the first unexposed portion is film.

In Diehr, the Court stated that when a claim containing non-statutory subject matter, in that case a mathematical formula, implements or applies that non-statutory subject matter in an article of manufacture or a process, and when considered as a whole the claimed invention performs a function which the patent laws were designed to protect, then the claim satisfies 101. In the present case, the alleged printed matter portion in conjunction with the other film elements (the unexposed film portion) is functioning to transform the undeveloped film into a picture. This picture has both images of the film elements alongside each other. Without the combination of these film elements, the unexposed portion with the exposed portion, this effect of placing separate pictures alongside each other would not be possible. See Ex Parte Dere 118 USPQ 541 (BPAI 1957). The court in Dere held that when there is a "relation between the printed matter and the physical structure causing the combination to be capable of being handled and applied to a useful end, subject matter within the statutes is present." In the present application, the combination of elements functions to transform them into an article that is a different useful thing. Thus, the "claims considered as a whole", represent an article of manufacture.

Furthermore, it is improper for the Examiner to dissect out and ignore all other claim known limitations and conclude the invention is merely directed to printed matter. See Ex Parte Carver 227 USPQ 465 (BPAI 1985). In Carver, the applicant claimed a "sound recording" (an article of manufacture) which the Examiner construed and treated according to the law applicable to printed matter and rejected under section 101. The court, in citing Diehr, stated the claims must be considered as a whole, and that the Examiner improperly ignored all the known claim limitations to determine the invention was a mere recording, the recording being non-statutory subject matter under section 101. Analogously, in the instant case, the Examiner dissects out the pre-exposed portion without considering the known limitation of the unexposed portion.

Accordingly, it is respectfully urged that the Examiner's rejections under 35 U.S.C. 101 of claims 1-8 are improper and should be reversed.

II. Conclusion

For all these reasons, applicant submits that the invention is statutory subject matter within the meaning of 35 U.S.C. section 101 and that the rejections are improper and should be withdrawn.

It is urged that the final rejection of claims 1-8 is untenable and should be reversed. Allowance of claims 1-8 is in order. Such action is solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, applicants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 19-3869.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 19-3869.

Respectfully submitted,
SPRUNG HORN KRAMER & WOODS

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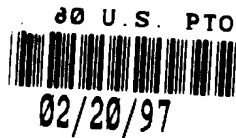
I hereby certify that this correspondence is being deposited with the United States Postal Services as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231 on February 10, 1997.

SPRUNG HORN KRAMER & WOODS

By William A. Suter, Jr.

Date February 10, 1997

APPENDIX



1. A sealed package of film to be opened, put into a camera and exposed to form a plurality of photographs, comprising a plurality of film items to be exposed, each film item comprising a first unexposed portion and a second exposed portion, whereby upon exposure of the first unexposed portion and development there is formed in said first portion a picture corresponding to the exposure alongside a picture corresponding to the second portion.
2. A package according to Claim 1, wherein each second portion at least in part surrounds its first portion essentially as a frame.
3. A package according to Claim 1, wherein each second exposed portion in the package is not developed, and is later developed simultaneously when its first portion is developed following exposure.
4. A package according to Claim 1, wherein the package is of instant developing film.
5. A package according to Claim 2, wherein the package is of instant developing film, each second portion being undeveloped in the package and being later developed

simultaneously when its first portion is developed following exposure.

6. A package according to Claim 1, wherein the second exposed portions of the several film items are not all identical.

7. A package according to Claim 1, wherein each second exposed portion in the package is developed.

8. A package according to claim 2, wherein the second exposed portions of the several film items are not all identical.